TROP, PRUNER & HU, P.C.
INTELLECTUAL PROPERTY LAW ATTORNEYS

1616 S. Voss Rd., Suite 750
Houston, Texas 77057-3621
Bus: (713) 468-8880
Fax: (713) 468-8883

Fax

To:	Technology Center Director	**From:**	Rhonda L. Sheldon
Company:	USPTO, Group Art Unit 2186	**Date:**	January 29, 2007
Fax:	(571) 273-8300	**Pages:**	6
Your Re:	10/751,258	**Our Re:**	ITL.1082US (P18346)

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MESSAGE:

Attorney Docket No.: ITL.1082US (P18346) RLS/njm
Date: January 29, 2007

Applicant(s): Michael K. Eschmann et al.
Serial No.: 10/751,258
Filing Date: December 31, 2003
Title: Coalescing Disk Write Back Requests

1. Petition to the Technology Center Director Under 35 U.S.C. § 1.181 and MPEP § 1002.02(c)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Michael K. Eschmann, et al.	§	Group Art Unit:	2186
Serial No.:	10/751,258	§	Examiner:	Paul W. Schlie
Filed:	December 31, 2003	§	Atty. Dkt. No.:	ITL.1082US (P18346)
For:	Coalescing Disk Write Back Requests	§	Assignee:	Intel Corporation
Customer No.:	21906	§	Confirmation No:	7473

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition to the Technology Center Director Under 37 C.F.R. § 1.181 and MPEP § 1002.02(c)

The examiner's final rejection is premature due to a §112 rejection that was first asserted in a final Office action. That is, none of the claims were rejected under § 112 in the prior, non-final Office action and none of the claims were amended after the first Office action. Given that the examiner did not reject any claims under §112 in the first Office action and waited to reject the claims under § 112 in a second and final Office action, the finality of the second Office action is believed to be premature.

Additionally, in the final Office action the examiner rejected the independent claims over the prior art based on a new ground of rejection. Because the independent claims were not amended in response to the first Office action an amendment did not necessitate the rejection. Thus, the finality of the second Office action is believed to be premature for this additional reason.

Date of Deposit: January 29, 2007
Pursuant to Rule 1.8(a), I hereby certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571/273-8300) on the date indicated above.
Nancy Meshkoff

Facts Involved

1. On May 4, 2006 the applicant filed a Request for Continued Examination (RCE). The RCE included a Preliminary Amendment, in which independent claims 1, 11, and 21 were amended.
2. On June 7, 2006, the examiner issued a first Office action after RCE.[1] In the Office action, claims 1, 11, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mason, Jr. (6,304,946). The dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandel (U.S. Application 2003/0088713). These were the only two rejections in the first Office action.
3. On August 10, 2006, the applicant replied to the First Office action. No amendments were made in this reply.
4. On October 13, 2006, the examiner issued a final Office action.[2] In the final Office action the examiner rejected claims 1-30 under 35 U.S.C. § 112 ¶ 1 and under 35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandel.
5. On November 3, 2006 the applicant filed a response to the final rejection. In the response, the applicant requested that the examiner reconsider the finality of the Office action in view of the new §112 and § 103(a) rejections. Additionally, the applicant amended the independent claims.
6. In the Advisory Action dated November 27, 2006,[3] the examiner refused to withdraw the finality of the Office action and he refused to enter the claim amendments.
7. Because the applicant does not agree with the examiner, the applicant brings this petition.

Points to be Reviewed

1. In view of the §112 rejection that was newly asserted in the Office action dated October 13, 2006 should the examiner have made that Office action a final Office action?

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[1] Paper No. 20060601
[2] Paper No. 20061005.
[3] Paper No. 20061121.

2. As the amendments to the claims overcome the §112 rejection did the examiner err in refusing to enter the amendments, which, if entered, would place the application in better form for appeal?
3. In view of the newly asserted § 103(a) rejection of the independent claims should the Office action dated October 13, 2006 have been a final Office action?

Requested Action

The decision-maker is requested to have the finality of the Office action dated October 13, 2006 withdrawn and to enter the amendments submitted on November 3, 2006. In the alternative, the decision-maker is requested to enter the amendments submitted on November 3, 2006.

Legal Argument

During the examination of a patent application, it is common practice to make a second Office action a final Office action.[4] But a second Office action should not necessarily be final if an issue was not yet clearly developed or if a new ground of rejection is asserted that was not necessitated by an amendment.[5] In this case, claims 1-30 were first rejected under §112 in a final Office action and the independent claims were first rejected under 35 U.S.C. § 103(a) which was *not* necessitated by and amendment. Given that the examiner did not reject any claims under §112 in a first Office action, instead waiting to reject the claims under §112 in a second and final Office action, is the finality of the second Office action premature? Furthermore, given that the independent claims were not previously rejected under 35 U.S.C. § 103(a) and that they were not amended after a first Office action, is the finality of the second Office action premature?

In this case, the examiner's rejection of the claims in a final Office action under §112 ¶1 for the first time is contrary to the Patent Office's policies.[6] Although present practice is to make a second action final this does not sanction hasty and ill-considered final rejections; the applicant is entitled to a full and fair hearing and a clear issue should be developed before appeal.[7] Furthermore, a second Office action on the merits should not be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's

[4] *See* MPEP §706.07(a).
[5] *See* MPEP §706.07; MPEP §706.07(a)
[6] Paper No. 12272005, page 2.

amendment of the claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).[8]

Because none of the claims were amended after response to the first Office action, the applicant was denied a full and fair hearing and/or the issues were not clear. The examiner could have rejected the claims under § 112 in the first Office action, but he did not. Moreover the examiner did not reject the independent claims under § 103(a) in the first Office action. Thus, it is submitted that the finality of the second Office action prematurely cut off prosecution of the application, preventing a clear issue from developing.

Even if the examiner did not voluntarily withdraw the finality of the second Office action he should have entered the amendments to overcome the §112 rejection. Amendments that place an application in better form for appeal or that comply with objections or rejection of form should be entered even if after a final rejection. [9] In the Advisory Action, the examiner refused to enter the amendments submitted after final because allegedly they did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.[10] If, however, the amendments overcome a § 112 rejection wouldn't this simplify the issues for appeal? Nevertheless, the amendments should have been entered because the independent claims were rejected on a new ground of rejection that was not necessitated by amendment, which precludes the second Office action (dated October 13, 2006) from being a final Office action. Accordingly, the decision maker is requested to withdraw the finality of the Office action dated October 13, 2006 and to enter the amendments.

Fee

A petition brought pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 20-1504 (ITL.1082US).

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[7] *Id.*
[8] MPEP § 706.07(a).
[9] MPEP § 714.13
[10] Paper No 01312006.

Statement that Petition is Timely Filed

The complained about action took place on November 27, 2006; this matter is believed to have been addressed within two months as January 27, 2007 fell on a Saturday, and this petition is being filed on the following Monday, January 29, 2007.

Respectfully submitted,

Date: January 29, 2007

Rhonda L. Sheldon
Registration No. 50,457
Trop, Pruner & Hu, P.C.
1616 S. Voss Road, Suite 750
Houston, TX 77057
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]

Attorneys for Intel Corporation